

REMARKS

Initially, Applicants have amended claims 194, 243, 252, 268-270, 277-284, 286-287, and 289 to more accurately claim the present invention and not for any reason related to 5 patentability. No new matter has been added. Applicants believe that the following comments will convince the Examiner that the rejections set forth in the February 28, 2003 Office Action have been overcome and should be withdrawn.

10

I. THE INVENTION

Generally, the present invention is a system for accessing electronic data via a familiar printed medium. Specifically, the familiar printed medium is a printed photograph comprising at least one machine recognizable feature, which may be one of various embodiments including, but not limited to, a watermark, bar code, invisible bar code, magnetic code, printed character, invisible icon, etc. In the present invention, a machine recognizable feature is scanned or sensed, and converted into an electronic signal, which is transmitted for processing. The processing results in the display of programming material related to the information contained in the printed photograph. Importantly, the present invention is

designed to allow a user to access programming material related to the printed photograph.

## II. THE EXAMINER'S REJECTIONS

### 5 A. DOUBLE PATENTING

The Examiner rejected claims 168, 284, and 287 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,932,863 (hereinafter referred to as the "'863 patent").

"Although the scope of claims 168, 284 and 287 of the present application and claim 1 of [the] '863 patent are almost identical, the difference between the present claimed invention and the '863 patent is that the present claimed invention is a broader recitation of the '863 patent."

(February 28, 2003 Office Action Summary, pp. 2-3, paragraph 2).

Also, the Examiner provisionally rejected claims 168-220, 242-245, and 253-259 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-221 and 224-263 of co-pending application Ser. No. 09/769,149 (hereinafter referred to as the "'149 application").

“Although the scope of claims 168-220, 242-245 and 253-289 of the present application and claims 168-221, [and] 224-263 of [the] ‘149 application are almost identical, the difference between the 5 present claimed invention and the ‘149 application is that the present claimed invention is a narrower recitation of the ‘149 application.” (February 28, 2003 Office Action Summary, p. 4, paragraph 3).

10

B. 35 U.S.C. § 103

The Examiner rejected claims 168-173, 176-178, 195-196, 220-241, 255-258, 263-265, 268, 279, 284, and 236-289 under 35 U.S.C. § 103(a) as being unpatentable over 15 Withnall et al. U.S. Patent No. 4,488,035 (hereinafter referred to as “Withnall”) in view of Fields U.S. Patent No. 4,481,412 (hereinafter referred to as “Fields”) and Utsugi U.S. Patent No. 4,601,573 (hereinafter referred to as “Utsugi”). The Examiner opined that Withnall discloses 20 a system that includes a feature recognition device that reads at least one machine recognizable feature on a “printed document” to display information on the display of a portable handset. However, the Examiner admitted that:

"Withnall et al fails to teach or fairly suggest that the displayed information is programming material and the system further comprising means for transmitting a coded signal in response to the recognition of the machine recognizable feature and an intelligent controller having associated therewith a means for accessing the programming material in response to receiving the coded signal." (February 28, 2003 Office Action Summary, p. 6, paragraph 6).

The Examiner contended that Fields teaches these features by disclosing a microcontroller accessing means that includes a "barcode electronic circuit" coupled to a barcode reader, wherein the microcontroller accesses and transmits programming material in response to receiving a coded signal. The Examiner argued that the system disclosed in Fields displays "video/image/programming/sound/pictorial/electronic/media data" on a "television/workbook."

The Examiner stated that combining the systems disclosed in Withnall and Fields would have been obvious at the time of Applicants' invention to provide:

"Withnall et al with a higher technology system wherein the user being provided with a full

complete [sic] information in a flexible ways [sic] ... such modification would have been an obvious extension as taught by Withnall et al."

(February 28, 2003 Office Action Summary, pp. 6-5, paragraph 6).

The Examiner then admitted that the Withnall and Fields combination fails to teach or suggest a printed photograph, which is argued to be taught by Utsugi. The Examiner stated that combining Utsugi with Withnall and 10 Fields would have been obvious for providing:

"[the] capability of retrieving data related to a desired photograph readily from the barcode. Furthermore, such modification would provide Withnall et al/Fields with a more secure system for [a] photograph's authorization, preventing 15 fraudulent use in duplicating photographs ... such modification would have been an obvious extension as taught by Withnall/Fields."

(February 28, 2003 Office Action Summary, p. 7, 20 paragraph 6).

Also, the Examiner rejected claims 174-175, 180-181, 183-184, 189-190, 192-193, 214-219, and 246-252 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Utsugi "as applied to claim 168" in

view of Roberts U.S. Patent No. 5,324,922 (hereinafter referred to as "Roberts") and Malec et al. U.S. Patent No. 5,287,266 (hereinafter referred to as "Malec"). The Examiner admitted that Withnall, Fields, and Utsugi fail to 5 teach online or home shopping and a cable television data link, and argued that these features are disclosed by Roberts. According to the Examiner, the combination of Roberts with Withnall, Fields, and Utsugi would have been obvious and would provide:

10 "a faster system due to the benefit of cable television transmitting capability. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi to provide the user [with] an 15 alternative way of doing shopping." (February 26, 2003 Office Action Summary, p. 8, paragraph 7).

Moreover, the Examiner admitted that Withnall, Fields, Utsugi, and Roberts all fail to disclose an Integrated 20 Services Digital Network ("ISDN") data link which, according to the Examiner, is disclosed by Malec. In the opinion of the Examiner, the combination of Malec with Withnall, Fields, Utsugi, and Roberts would have been obvious for providing:

“a more accurate and faster system due to the benefit of ISDN networking line[s]. Furthermore, such modification would have been an obvious extension as taught by Withnall et al./Fields/Utsugi/Roberts and would have mere[ly] been a substitution of equivalents.” (February 28, 2003 Office Action Summary, p. 8, paragraph 7).

Next, the Examiner rejected claims 179, 182, 286-288, 10 191, 194, 199-201, 203-204, 209-210, 213, 242-245, 253-254, 262, 267, 269-271, 282, and 285 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Utsugi “as applied to claims 168 and 284” in view of Bravman et al. U.S. Patent No. 5,401,944 (hereinafter referred to as “Bravman”). The Examiner admitted that Withnall, Fields, and Utsugi fail to teach displaying information on a wireless communication device. According to the Examiner, Bravman teaches a remote unit providing travel-related information, and the combination of 15 Withnall, Fields, Utsugi, and Bravman would have been obvious for providing:

“a more flexibility system [sic] wherein the system is capable of providing the user all of his/her desired information about the

trip/vacation that he/she is about to take, and thus providing a more user-friendly system.

Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi." (February 28, 2003 Office

5 Action Summary, p. 9, paragraph 8).

Also, the Examiner rejected claims 197, 202, and 205 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Utsugi "as applied to 10 claim 168" in view of Waterbury German Patent No. DT 24 52 202 A1 (hereinafter referred to as "Waterbury"). The Examiner admitted that Withnall, Fields, and Utsugi fail to teach an invisible machine recognizable feature, which is argued to be taught by Waterbury. The Examiner asserted 15 that the combination of Waterbury with Withnall, Fields, and Utsugi would have been obvious for providing:

"a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, and thus preventing 20 manipulating by a fraudulent user. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi." (February 28, 2003 Office Action Summary, pp. 9-10, paragraph 9).

Additionally, the Examiner rejected claims 198 and 212 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Utsugi "as applied to claim 168" in view of Tannehill *et al.* U.S. Patent No. 5,158,310 (hereinafter referred to as "Tannehill"). The Examiner admitted that Withnall, Fields, and Utsugi fail to teach a magnetic "code/strip," which is argued to be taught by Tannehill. According to the Examiner, the aforementioned combination would have been obvious for providing Withnall, Fields, and Utsugi with an alternative method for encoding data. "Furthermore, such modification would have merely been a substitution of equivalents." (February 28, 2003 Office Action Summary, p. 10, paragraph 10).

Also, the Examiner rejected claims 206-208 and 211 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and Utsugi "as applied to claim 168" in view of Schach *et al.* U.S. Patent No. 5,397,156 (hereinafter referred to as "Schach") and Waterbury. The Examiner referenced Schach for teaching a watermark. In the Examiner's opinion, the combination of Schach with Withnall, Fields, and Utsugi would have been obvious for aesthetic purposes. "[S]uch modification would have been an obvious extension as taught by Withnall et

al/Fields/Utsugi." (February 28, 2003 Office Action Summary, p. 11, paragraph 11).

The Examiner then admitted that Withnall, Fields, Utsugi, and Schach fail to teach an invisible watermark, 5 which is argued to be taught by Waterbury. The Examiner asserted that the combination of Withnall, Fields, Utsugi, Schach, and Waterbury would have been obvious for providing:

10 "a more secure system wherein the data recorded in the machine recognizable feature is invisible to [the] naked eye, thus preventing manipulating by [a] fraudulent user. Furthermore, such modification would have been an obvious extension 15 as taught by Withnall et al/Fields/Utsugi/Schach et al." (February 28, 2003 Office Action Summary, p. 11, paragraph 11).

Also, the Examiner rejected claims 185, 259-261, 263, 267, 272-278, 280-281, and 283 under 35 U.S.C. § 103(a) as being unpatentable over Withnall as modified by Fields and 20 Utsugi "as applied to claim 168 and 301" in view of Morales U.S. Patent No. 5,872,589 (hereinafter referred to as "Morales"). The Examiner admitted that Withnall, Fields, and Utsugi fail to teach a display unit comprising a "personal planner/phone/pager," which is argued to be

taught by Morales. In the Examiner's opinion, combining Withnall, Fields, Utsugi, and Morales would have been obvious to provide:

5 "the user with the flexibility of selecting his/her desired display unit that is fitting [sic] his/her needs, thus providing a more user-friendly system. Furthermore, such modification would have been an obvious extension as taught by Withnall et al/Fields/Utsugi." (February 28, 2003  
10 Office Action Summary, p. 12, paragraph 12).

### III. THE EXAMINER'S REJECTIONS SHOULD BE WITHDRAWN

#### A. DOUBLE PATENTING

The Examiner rejected claims 168, 284, and 287 under  
15 the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of the '863 patent. In response, Applicants are filing a Terminal Disclaimer herewith to overcome the Examiner's double patenting rejection.

20 Also, the Examiner provisionally rejected claims 168-220, 242-245, and 253-289 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 168-221 and 224-263 of the '149 application. In response, Applicants are filing a Terminal

Disclaimer herewith to overcome the Examiner's double provisional patenting rejection.

B. 35 U.S.C. § 103

The Examiner rejected claims 168-173, 176-178, 195-5 196, 220-241, 255-258, 263-265, 268, 279, 284, and 286-289 under 35 U.S.C. § 103(a) as being unpatentable over Withnall in view of Fields and Utsugi. Applicants respectfully disagree and submit that none of the aforementioned claims are obvious in view of Withnall, 10 Fields, and Utsugi. In order for a claimed invention to be obvious in view of a combination of references, three criteria must be met: 1) there must exist a suggestion or motivation to modify the reference or to combine reference teachings; 2) there must be a reasonable expectation of 15 success; and 3) the prior art references, when combined, must teach or suggest all of the claim limitations. (see *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)) (see also Manual of Patent Examining Procedure §§ 2143-2143.03).

Initially, Applicants submit that no suggestion or 20 motivation to modify or combine Withnall, Fields, and Utsugi exists.

25 "Standing on their own, these references provide no justification for the combination asserted by the Examiner. "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some

teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital  
5 Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original).

The Examiner contended that it would have been obvious  
10 to combine the teachings of Withnall, Fields, and Utsugi to arrive at the various embodiments of Applicants' invention. Yet, the Examiner has cited only purported benefits of this combination without pointing to what motivation is provided by the references themselves. Applicants submit that no  
15 combination of these references would have been obvious to one of skill in the art at the time of Applicants' invention. Specifically, Withnall discloses a system for easing the examination of commuter tickets for validity. This purpose is far removed from the intent of the training  
20 system disclosed by Fields. The training system of Fields is used to provide a user with audio/visual output from a videodisc player coinciding with material presented in a training manual. Neither Withnall nor Fields relate to Utsugi, which teaches a photograph mount for holding a  
25 plurality of photographs on a continuous strip. The differing purposes of these references have no overlap in use, and therefore, would not provide one skilled in the art with a motivation or suggestion to combine these

references. Thus, an inventive step must be performed for one skilled in the art to arrive at the idea of combining any features of Withnall, Fields, and Utsugi in any combination.

5       Upon reconsideration, the Examiner will undoubtedly recognize that the reasons put forth for the § 103(a) rejection actually support an "obvious to try" argument. Of course, "obvious to try" is not the standard for obviousness under 35 U.S.C. § 103." Hybritech, Inc. v.  
10 Monoclonal Antibodies, Inc., 231 U.S.P.Q. 81, 91 (Fed. Cir. 1986).

Under these circumstances, Applicants respectfully submit that the Examiner has succumbed to the "strong temptation to rely on hindsight." Orthopedic Equipment Co.  
15 v. United States, 702 F. 2d 1005, 1012, 217, U.S.P.Q. 193, 199 (Fed. Cir. 1983):

20       "It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claim in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law."

25       Applicants submit that the only suggestion or motivation for the Examiner's combination of references is provided by the teachings of Applicants' disclosure. No such suggestion or motivation is provided by the references

themselves; nor could there be in view of the difference in subject matter and the corresponding goals thereof.

In addition to the lack of suggestion or motivation to combine Withnall, Fields, and Utsugi, there is no expectation of success for the combination of these references, and any possible resulting device would not teach or suggest all of the limitations of the rejected claims. Withnall discloses a machine capable of scanning a bar code on a commuter ticket and subsequently displaying the validity of the ticket based on information stored in a memory means. Fields discloses a system for reading a bar code on a training manual for playing corresponding material from a videodisc. Utsugi discloses a photograph mounting apparatus comprising a continuous strip designed to hold multiple photographs. Applicants respectfully submit that the combination of Withnall, Fields, and Utsugi cannot be successfully combined to disclose the means for accessing programming material associated with a database. Importantly, claims 168, 284, and 287 all disclose the accessing of programming material resulting from recognition of a machine recognizable feature. The programming material of the present invention is designed such that it can be easily altered or updated at any time. As a result, a user is provided with the most recently

updated version of the associated information (or programming material) upon scanning a photograph. This is not possible with the combination of Withnall, Fields, and Utsugi. Any attempt of implementing the videodisc player 5 of Fields with Withnall would require the videodisc player to be located on a vehicle, e.g., a bus. Therefore, anytime information must be updated, a new videodisc must be inserted into the videodisc player. This is not feasible, especially because the validity of a ticket can 10 change each time a ticket is used and could require a new videodisc to be employed every time a ticket is used. Moreover, the radio data link of Withnall cannot be utilized to access a remote videodisc player or other such 15 audio/visual material because the radio data link is designed only for transmitting a validity state and not substantially different audio/visual material. In particular, audio/visual material requires substantially more data to be transmitted in a specialized format. Thus, 20 a system for achieving such transmission would need to be invented and implemented for remotely accessing such material. Moreover, the addition of Utsugi to Withnall and Fields would not compensate for the inadequacies of Withnall and Fields. Utsugi only discloses a photograph mount which may display a bar code. However, Utsugi can in

no way assist in providing readily updateable programming material as in the claimed invention. In fact, Utsugi fails to disclose any subject matter even remotely relating to programming material.

5 In sum, any attempt to combine Withnall, Fields, and Utsugi to create the present invention would be unsuccessful and would fail to provide the flexible, updateable system (including a system for obtaining and surveying correlated programming material) of the claimed 10 invention. Moreover, the dynamic programming material of the claimed invention is not disclosed by the combination of these references.

In view of the foregoing, base claims 168, 284, and 287 cannot be unpatentable over Withnall, Fields, and 15 Utsugi. The remaining rejected claims are dependent on these claims and contain all of the limitations of their respective base claims. Therefore, these dependent claims are also not unpatentable over these references.

In all subsequent rejections, the Examiner noted the 20 deficiencies of the Withnall, Fields, and Utsugi combination regarding matter disclosed in dependent claims and appended various other references including Roberts, Malec, Bravman, Waterbury, Tannehill, Schach, and Morales to the combination in order to provide the additional

features of the dependent claims. However, the combination of Withnall, Fields, and Utsugi has been shown to be not only improper, but also to lack the disclosure of each and every element of the base claims. Because this combination 5 is improper and incomplete, any further combination of references with Withnall, Fields, and Utsugi would also be improper. Thus, Applicants respectfully submit that all remaining rejections have also been overcome and should be withdrawn.

CONCLUSION

Applicants submit that all pending claims represent a patentable contribution to the art and are in condition for allowance. No new matter has been added. Early and  
5 favorable action is accordingly solicited.

Respectfully submitted,

Date: May 28, 2003

John W. Olivo, Jr.  
Reg. No. 35,634  
Ward & Olivo  
382 Springfield Ave.  
Summit, NJ 07901  
908-277-3333

10